

## **REMARKS**

Applicant has carefully reviewed the Final Office Action dated July 11, 2008. Favorable reconsideration is respectfully requested in view of the above amendments and the following comments. Claims 1 and 10 have been amended to include the elements previously recited in claims 14 and 15, respectively. No new issues have been raised, as the elements of claims 14 and 15 have already been considered by the Examiner.

Applicant thanks the Examiner for extending the courtesy of a teleconference with his representative on September 2, 2008. At that time, the Examiner indicated that he would enter an amendment in which claims 1 and 10 were amended to include the elements of claims 14 and 15, respectively as this amendment was not expected to raise new issues or require a new search. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 1-4, 6, 10 and 12-13 under 35 U.S.C. §102(b) as being anticipated by Herrmann et al., U.S. Publication No. 2002/0030360. Claims 1 and 10 have been amended to include the elements of claims 14 and 15, respectively, thereby rendering the rejection moot. Applicant does not concede the correctness of the rejection. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 1, 3, 5, 7, 8, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by Keller et al., U.S. Publication No. 2005/0104364. Claims 1 and 10 have been amended to include the elements of claims 14 and 15, respectively, thereby rendering the rejection moot. Applicant does not concede the correctness of the rejection. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Herrmann et al., U.S. Publication No. 2002/0030360, in view of Admitted Prior Art. Claim 1, from which claim 9 depends, is distinguished above as being patentable over Herrmann et al. Applicant's Admitted Prior Art does not remedy the noted shortcomings of Herrmann et al., and thus claim 1 is patentable over both. Claim 9 includes the elements of claim 1 and thus is patentable for at least the same reasons. Claim 9 also adds further distinguishing features. Favorable reconsideration is respectfully requested.

Applicant respectfully traverses the Examiner's rejection of claims 1, 10, 14 and 15 under 35 U.S.C. §103(a) as being unpatentable over Goguelin et al., U.S. Patent No. 6,630,055, in view

of Herrmann et al. Applicant respectfully asserts that there is no proper or reasonable motivation to combine these references as suggested by the Examiner, particularly as required by *KSR*.

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.* quotes *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006):

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.

Emphasis added; see page 14 of the April 30, 2007 decision. The Court further stated:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.

See page 14 of the April 30, 2007 decision. Applicant believes that the Examiner has failed to provide “an articulated reasoning with some rational underpinning” to support his obviousness rejection.

In particular, the Examiner has asserted that it would be obvious to provide the “zone of reduced thickness” of Goguelin et al. with “a cover foil in view of Herrmann et al. to afford a paper with reduced thickness with stability”. This is inappropriate. Goguelin et al. are silent as to any issues with stability, or weakness. The only documentation of record that recognizes or discusses any possible issue with weakness caused by Goguelin et al.’s “zone of reduced thickness” is within the Background section of Applicant’s patent application. It is not appropriate to rely upon the instant application in ascribing characteristics to the primary reference. The Examiner’s attempts to the contrary appear to be little more than reconstructive hindsight. It is axiomatic that this is not proper.

The Examiner is correct in noting that Herrmann et al. may ascribe a cover foil with the property of improving stability. However, Herrmann et al. are directed to the problem of dealing with a reduction in stability caused by a through opening that is formed in the substrate. Recognizing that a through opening may cause a reduction in stability cannot reasonably be considered equivalent to recognizing that a zone of reduced thickness may suffer from a reduction in stability.

Indeed, it will be recognized that in the zone of reduced thickness, no material has actually been removed. Rather, the paper fibers and coating material have been compressed. As

no material has been removed, one cannot reasonably assume that the zone of reduced thickness would exhibit any weakness. Again, the Examiner cannot properly rely upon any discussion thereof that is found only within the instant application.

Moreover, it is noted that the primary reference describes a form of watermark. As one of skill in the art will appreciate, a watermark is intended to be viewed. Consequently, one of skill in the art would not be motivated to cover the watermark with something such as a cover foil. Again, there is no motivation to combine these references as suggested.

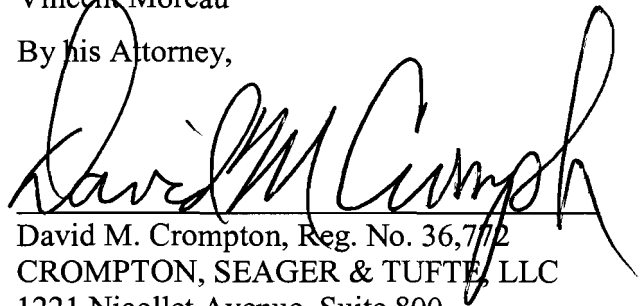
The Examiner has failed to provide a properly articulated reason as to why one of ordinary skill in the art would combine these references as suggested. The rejection is flawed and should be withdrawn. Favorable reconsideration is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Vincent Moreau

By his Attorney,

A large, stylized handwritten signature in black ink, appearing to read "David M. Crompton".

David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: \_\_\_\_\_

9/11/08